

Serial No. 09/611,633

Page 9

REMARKS

Claims 1-21 are pending in this application.

The Office Action maintains the rejection of claim 1 under the judicially created doctrine of obviousness type double patenting over claim 1 of Goldberg (U.S. Patent No. 5,530,437) and LaPorta et al. (U.S. Patent No. 5,918,158). The Office Action also maintains the rejection of claims 2, 10, 16, and 19-21 under the judicially created doctrine of obviousness type double patenting over claims 1, 8, 9, and 12-14 of Goldberg. These rejections are respectfully traversed.

The Office Action additionally maintains the rejections, under 35 U.S.C. § 103, of claims 1-4, 10-12, and 15-21 over Goldberg and LaPorta et al., claims 1-10, 12, and 14-21 over Goldberg and Ries et al. (U.S. Patent No. 5,973,613), and claim 13 over Goldberg, Ries et al. and Lemelson (U.S. Patent No. 6,054,928). These rejections are respectfully traversed.

Applicant asserts these rejections are deficient because the Office Action still not met the burden of establishing a *prima facie* case of obviousness. In particular, the Office Action has not provided proper motivation to combine the reference teachings to teach the claimed invention. Because there is no motivation to combine the reference teachings to obtain the claimed invention, both the double patenting rejections and the rejections under 35 U.S.C. §103 are deficient.

More particularly, no reference or combination of references disclose any benefit or deficiency in LaPorta et al. or Ries et al. that would necessitate one of ordinary skill in the art to modify Goldberg to obtain the claimed invention or vice versa. The deficiencies and/or benefits are also not provided by knowledge of one of ordinary skill in the art.

As asserted in the previous Amendments, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on

Serial No. 09/611,633

Page 10

applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

Also, according to MPEP § 804, a double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

The Office Action still has not provided any benefit in LePorta et al. that would necessitate one of ordinary skill in the art to modify Goldberg to obtain the claimed invention or vice versa. In particular, even if LePorta were combined with Goldberg, the combination does not result in the claimed invention. More particularly, the Office Action does not establish how the combination achieves the claimed plurality of orthogonal codes corresponding to a plurality of canned messages, where one of the canned messages is selected to be transmitted in response to a triggering event and one of the plurality of codes corresponding to the selected message is transmitted.

The Office Action only states, in attempting to establish motivation, the result of "an acknowledgement-back system that is able to support two-way messaging and the use of canned messages... while allowing co-channel responses of multiple recipients to be received simultaneously at central controller 102 (see Goldberg, Abstract)." If the Office Action is trying to imply the Abstract of Goldberg provides motivation to achieve a plurality of orthogonal codes corresponding to a plurality of canned messages, Applicant disagrees. In particular, the Abstract of Goldberg does not mention anything about using an orthogonal code to correspond to a canned message. More importantly, the Abstract of Goldberg only discloses using the teachings of Goldberg to "correctly identify a portion of a group" of at least two portable communication units responding to a system generated poll. Thus, there is no teaching or motivation in the Abstract, or anywhere else, in Goldberg to use the claimed orthogonal codes to correspond to a plurality of canned messages. Furthermore, various other techniques can be used for messaging

Serial No. 09/611,633
Page 11

to avoid collisions of actual messages in communication systems, such as code division multiple access and time division multiple access. Thus, aside from there being no motivation to do so, there would be absolutely no need to use the teachings of Goldberg to avoid any collisions between the messages of LePorta.

In fact, the combination of LePorta and Goldberg would only result in using the teachings of LePorta for sending stored messages while using the teachings of Goldberg for identifying respondents to a system-generated poll.

Thus, the Office Action still has not provided any benefit in LePorta et al. that would necessitate one of ordinary skill in the art to modify Goldberg to obtain the claimed invention or vice versa.

The Office Action also still has not provided any benefit in Reis that would necessitate one of ordinary skill in the art to modify Goldberg to obtain the claimed invention or vice versa. In particular, even if Reis were combined with Goldberg, the combination does not result in the claimed invention. More particularly, the Office Action does not establish how the combination achieves the claimed plurality of orthogonal codes corresponding to a plurality of canned messages, where one of the canned messages is selected to be transmitted in response to a triggering event and one of the plurality of codes corresponding to the selected message is transmitted.

The Office Action only states, "It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Reis as taught by Goldberg because orthogonal codes enable a plurality of pagers to simultaneously transmit IDs or canned reply messages on the same communication channel (see Goldberg's Abstract)..." Applicant disagrees with this mischaracterization of Goldberg's Abstract. In particular, there is absolutely no disclosure of simultaneously transmitting canned reply messages in the Abstract of Goldberg. As discussed above, the Abstract of Goldberg does not mention anything about using an orthogonal code to correspond to a canned message. More importantly, the Abstract of Goldberg only discloses using the teachings of Goldberg to "correctly identify a portion of a group" of at least two portable communication units responding to a system generated poll. Thus, there is no teaching or motivation in the Abstract, or anywhere else, in Goldberg to use the claimed

Serial No. 09/611,633
Page 12

orthogonal codes to correspond to a plurality of canned messages. Furthermore, various other techniques can be used for messaging to avoid collisions of actual messages in communication systems, such as code division multiple access and time division multiple access. Thus, aside from there being no motivation to do so, there would be absolutely no need to use the teachings of Goldberg to avoid any collisions between the messages of Reis.

In fact, the combination of Reis and Goldberg would only result in using the teachings of Reis for sending canned reply messages while using the teachings of Goldberg for identifying respondents to a system-generated poll.

Thus, the Office Action still has not provided any benefit in Reis that would necessitate one of ordinary skill in the art to modify Goldberg to obtain the claimed invention or vice versa.

Regarding the paragraph 3. on page 5, Applicant assume the Office Action is referring to the Goldberg reference when stating "Goldman."

Furthermore, Applicants traverse the mischaracterization of Goldberg's Abstract. In particular, the Office Action states "Gold[berg], likewise provide motivation in the Abstract for using orthogonal codes that correspond to the canned messages since the use of orthogonal codes enable a plurality of messages to be received simultaneously, thereby conserving frequency spectrum." Applicant disagrees. The Abstract of Goldberg does not mention anything about canned messages. In fact, Applicant traverses the Office Action's attempts to take Applicant's own realization of the benefits of the claimed combination and to pass the combination off as obvious without a foundation for motivation in any of the references. There is absolutely no teaching or motivation in the references of using the claimed orthogonal codes to represent canned messages and the Office Action has not asserted such is well known.

The remaining arguments listed below are taken from the previous response and are provided as a courtesy for examination and understanding of Applicant's position:

The Office Action has not provided any benefit or deficiency in LePorta et al. that would necessitate one of ordinary skill in the art to modify Goldberg to obtain the claimed invention or vice versa.

The Office Action admits "Goldberg fails to teach (1) pre-programming each PCU with orthogonal codes that correspond to a plurality of canned messages, (2) each PCU detecting a

Serial No. 09/611,633

Page 13

triggering event that does not originate from and is not controlled by the wireless communication system; and (3) each PCU selecting and transmitting one of the plurality of canned messages in response to the triggering event," (page 8). The Office Action then alleges "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Goldberg as taught by LaPorta because the steps of (1) pre-programming each PCU with orthogonal codes that correspond to a plurality of canned message in addition to each PCU's unique code steps, (2) detecting a triggering event that does not originate from and is not controlled by the wireless communication system, and (3) selecting and transmitting one of the plurality of canned message in response to the triggering event provide an easy way for a recipient to respond to a message with limited bandwidth usage (see LaPorta, Col. 6, lines 56-59 and Col. 13, lines 5-8) while allowing co-channel responses of multiple recipients to be received simultaneously at central controller 102 (see Goldberg, Abstract), thus conserving frequency spectrum," (pages 8-9). Applicant disagrees.

In particular, the mentioned sections of LaPorta et al. do not provide, and none of the other sections of LaPorta et al. provide motivation to combine the teachings of the two-way messaging system disclosed in LaPorta et al. with the acknowledge-back communication system disclosed in Goldberg. Goldberg is directed to an ack-back system (col. 3, lines 55-57) and does not disclose usefulness in a system using dynamically customizable messages. LaPorta et al. is directed to a system utilizing dynamically customizable messages (col. 1, lines 10-15) and does not disclose usefulness in an ack-back system.

For example, the section cited by the Office Action, col. 6, lines 56-59, states "The user agent 12 also provides other benefits. Because messages are expanded inside the messaging network 14, the bandwidth on the uplink can be reduced, allowing bandwidth asymmetry on the wireless link." This only discloses the benefits of expanding messages from reply codes such as those discussed at col. 5, lines 36-39 and illustrated in Fig. 9. This does not disclose expanding acknowledgement responses in the acknowledge-back communication system disclosed in Goldberg. More particularly, the reply messages in LaPorta et al. are messages that are destined to be read by humans, thus they must be expanded. To the contrary, in the acknowledge-back system disclosed in Goldberg, identification bit patterns are transmitted to acknowledge receipt

Serial No. 09/611,633

Page 14

of a page to a central controller 102 (col. 4, lines 38, 41-43, and 51-57). These identification bit patterns are not human readable messages. Thus, there is no need to expand messages in Goldberg and col. 6, lines 56-59 does not provide motivation to combine the references.

Furthermore, col. 13, lines 5-8 does not provide motivation. This section only states, "The design of these message types is strongly influenced by the capability of the messaging device. For example, the lack of a keyboard implies that free form messages are impractical." Applicant does not understand how there could be any motivation to combine the references present in this section and the Office Action has not clarified such. Also, this section also is only referencing the human-readable messages discussed above, and not the acknowledgement responses disclosed in Goldberg.

Additionally, the Abstract of Goldberg does not provide motivation to combine the teachings of the two-way messaging system disclosed in LaPorta et al. with the acknowledgement-back communication system disclosed in Goldberg. In particular, the Abstract of Goldberg only discloses the benefits of using a bit pattern to identify a portable communication unit (PCU) when responding to a poll requesting the identities of the PCUs. This does not amount to motivation to utilize the teachings of Goldberg in the two-way wireless messaging system disclosed in LaPorta et al. More particularly, the process described in the Abstract of Goldberg is a process used in the acknowledgement-back communication system disclosed in Goldberg (col. 3, lines 55-58). There is no disclosure that the two-way messaging system disclosed in LaPorta et al. requires teachings that are used in a acknowledgement-back communication system. Thus, the Abstract of Goldberg does not provide motivation to combine the teachings of the two-way messaging system disclosed in LaPorta et al. with the acknowledgement-back communication system disclosed in Goldberg. Furthermore, none of the other sections of Goldberg provide such motivation.

Accordingly, the Office Action has not provided a *prima facie* case of obviousness because it has not provided proper motivation to combine the teachings of the two-way messaging system disclosed in LaPorta et al. with the acknowledgement-back communication system disclosed in Goldberg.

Serial No. 09/611,633

Page 15

Additionally, even if the teachings of Goldberg and LaPorta et al. were combined, such a combination would not result in using a plurality of orthogonal codes corresponding to a plurality of canned message that produces an interference symbol pattern that provides a non-zero probability of correctly decoding at least some of a group of messages. In particular, the combination of the teachings of the two references would only result in a system that uses Goldberg's bit patterns corresponding to a portable communication unit to produce an interference pattern to correctly identify a portable communication unit along with separately using LaPorta et al.'s pre-canned messages to allow user's to easily respond to questions, such as lunch choices, from other users (col. 5, lines 11-27). Thus, even if the teachings of Goldberg and LaPorta et al. were combined, such a combination would not result in the claimed invention.

Furthermore, the Office Action has also not provided any benefit or deficiency in Ries et al. that would necessitate one of ordinary skill in the art to modify Goldberg to obtain the claimed invention or vice versa.

The Office Action admits "Ries fails to teach that the codes corresponding to a plurality of canned messages are orthogonal and are chosen such that when a group of different canned messages are received simultaneously by a local cellular transceiver of wireless processing device, the interference symbol pattern[n] provides a non-zero probability of correctly decoding at least some of the canned messages and a substantially zero probability of erroneously decoding a canned message not in the group," (page 15). The Office Action goes on to allege "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Ries as taught by Goldberg because the use of the slotted ALOHA protocol and orthogonal codes enable a plurality of pagers to simultaneously transmit canned reply message on the same communications channel while enabling a local cellular transceiver to correctly identify the interfering messages, thus improving the system's functionality and efficiency." (page 16). Applicant disagrees.

In particular, the Office Action has not provided any section of Ries et al. that provides, and in fact, none of the sections of Ries et al. provide motivation to combine the teachings of the personal messaging system using a batch collection protocol disclosed in Ries et al. with the acknowledge-back communication system disclosed in Goldberg. Goldberg is directed to an

Serial No. 09/611,633

Page 16

ack-back system (col. 3, lines 55-57) and does not disclose usefulness in a system using predetermined reply messages. Ries et al. is directed to a personal messaging system that let a user read a paging message and select a stored predetermined reply message (title, abstract) and does not disclose usefulness in an ack-back system.

In fact, the Office Action provides no foundation for any possible motivation to combine the teachings of Ries et al. and Goldberg. The Office Action only makes a conclusory statement regarding motivation. This does not satisfy the requirement of MPEP 2142, which requires there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. In particular, the Office Action does not cite any section of the references providing this motivation and the Office Action does not allege the motivation is in the knowledge generally available to one of ordinary skill in the art. Thus, the Office Action provides no foundation for any possible motivation to combine the teachings of Ries et al. and Goldberg.

Accordingly, the Office Action has not provided a *prima facie* case of obviousness because it has not provided proper motivation to combine the teachings of the two-way messaging system disclosed in Ries et al. with the acknowledge-back communication system disclosed in Goldberg.

Additionally, even if the teachings of Goldberg and Ries et al. were combined, such a combination would not result in using a plurality of orthogonal codes corresponding to a plurality of canned message that produces an interference symbol pattern that provides a non-zero probability of correctly decoding at least some of a group of messages. In particular, the combination of the teachings of the two references would only result in a system that uses Goldberg's bit patterns corresponding to a portable communication unit to produce an interference pattern to correctly identifying a portable communication unit along with separately using Ries et al.'s batch collection protocol to process communication signals during a batch session. Therefore, even if the teachings of Goldberg and Ries et al. were combined, such a combination would not result in the claimed invention.

Serial No. 09/611,633

Page 17

Thus, there is no motivation to combine any of the references to achieve the invention claimed in independent claim 1, and similarly claimed in independent claims 11 and 16. Accordingly, both the double patenting and the obviousness rejections are deficient.

Therefore, Applicant respectfully submits that independent claims 1, 11, and 16 define patentable subject matter. The remaining claims depend from the independent claims and therefore also define patentable subject matter. Accordingly, Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 103.

CONCLUSION

Based on the foregoing amendments and remarks, Applicant respectfully submits this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Serial No. 09/611,633

Page 18

The Commissioner is hereby authorized to deduct any additional fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,



Matthew C. Loppnow
Attorney for Applicant
Registration No. 45,314

Dated: July 22, 2004

Phone No. (847) 523-2585
Fax No. (847) 523-2350

Please send correspondence to:
Motorola, Inc.
Intellectual Property
600 North U.S. Highway 45
Libertyville, IL 60048